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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,023	02/28/2001	Philip Edwin Howse	REF/HOWSE/09	5866

7590

08/15/2002

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EXAMINER

PIASCIK, SUSAN L

ART UNIT

PAPER NUMBER

3643

DATE MAILED: 08/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/736,023

Applicant(s)

HOWSE ET AL.

Examiner

Susan L Piascik

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

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Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Subject matter critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The examiner feels that the applicant must claim the structure of the trap, including the magnetized plates, in order to provide novelty to the invention. As the claims read now, there is not a significant difference between the functionality of the particles disclosed by the applicant and the particles disclosed by Nobbs (US 5,771,628) without claiming the magnetic plate structure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 provide for the use of a particulate composition to kill pests, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it

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merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claim 1**, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Additionally, the claim language "containing or consisting of" is confusing. Please clarify.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nobbs in view of Howse ('543)

In regards to **claim 1**, Nobbs discloses a method of trapping and/or killing pests, such as insects, wherein at least a part of a pest to be trapped or killed is exposed to a particulate composition comprising particles. Nobbs discloses a wide variety of potential materials to use in the composition, however, fails to mention the use of a magnetic material. However, since the composition composed of a magnetic material is the functional equivalent of a composition comprised of an electrostatic material, in regards to the Nobbs reference, one of ordinary skill in the art would have found it obvious to substitute a magnetic "filler" for the electrostatic "filler" disclosed by Nobbs. Additionally, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

Further, Howse particularly mentions using pesticides and behavior modifying chemicals as additional particles in the composition. Therefore, since it was well known in the art at the time of the invention, one having ordinary skill in the art would have found it obvious to modify the composition of Nobbs, to include pesticides, etc., as taught by Howse, to make the composition more lethal to pests.

In regards to **claim 2**, Nobbs, as modified, discloses the claimed invention except for specifying the exact size of the particles. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to determine numerical values for the sizes, since it has been held that where the general conditions of a claim are

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disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

In regards to **claim 3**, Nobbs, as modified, discloses the claimed invention except for specifying the magnetic material. However, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

In regards to **claim 4**, Nobbs, as modified, teaches a method wherein the particles are applied to a surface in an area in which pests are present, preferably a surface which is inclined to the horizontal.

In regards to **claim 5**, Nobbs, as modified, discloses the claimed invention except for specifying the amount of magnetic particles. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to determine a numerical value, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

In regards to **claim 6**, Nobbs, as modified, teaches a method wherein the pesticides or behavior modifying chemicals (see Howse column 3, lines 47-56) are admixed with the particles of the magnetic material.

In regards to **claim 7**, Nobbs, as modified, teaches a method wherein the pesticides or behavior modifying chemicals (see Howse column 3, lines 58-68) are coated onto the particles of the magnetic material.

In regards to **claim 8**, Nobbs, as modified, fails to teach a method wherein the particles are composites which comprise a core of inert substrate that can be impregnated with the magnetic material. However, it has been held to be within the general skill of a

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worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. Also, impregnating materials to achieve desired characteristics, such as magnetic properties, is well known in the art of material science.

In regards to **claim 9**, Nobbs, as modified, discloses the claimed invention except for specifying the core material. However, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

In regards to **claim 10**, Nobbs, as modified, teaches adding pesticides or behavior modifying chemicals to the composition. Therefore, the addition of these materials to the composition, despite the method used to incorporate them, would have been obvious to one having ordinary skill in the art.

In regards to **claim 11**, Nobbs, as modified, teaches a method wherein the pesticide is an insecticide, fungicide, acaricide, insect growth regulator or chemosterilant.

Regarding **claim 12**, Nobbs, as modified, teaches a method wherein the pesticide is a bacterium, virus or fungus.

In regards to **claim 13**, Nobbs, as modified teaches a method wherein the behavior modifying chemical is a pheromone.

Regarding **claim 14**, Nobbs, as modified, discloses the claimed invention except for specifying the amount of cores by weight. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to determine a numerical value, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

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In regards to **claim 15**, Nobbs discloses a pesticidal composition in particulate form. Nobbs fails to teach a composition wherein the particles are composites which comprise a core of inert substrate that can be impregnated with the magnetic material. However, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. Also, impregnating materials to achieve desired characteristics, such as magnetic properties, is well known in the art of material science.

Additionally, since a composition composed of a magnetic material is the functional equivalent of a composition comprised of an electrostatic material, in regards to the Nobbs reference, one of ordinary skill in the art would have found it obvious to substitute a magnetic “filler” for the electrostatic “filler” disclosed by Nobbs. Additionally, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

Further, Howse particularly mentions using pesticides and behavior modifying chemicals as additional particles in the composition. Therefore, since it was well known in the art at the time of the invention, one having ordinary skill in the art would have found it obvious to modify the composition of Nobbs, to include pesticides, etc., as taught by Howse, to make the composition more lethal to pests.

In regards to **claim 16**, Nobbs, as modified, discloses the claimed invention except for specifying the core material. However, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

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In regards to **claim 17**, Nobbs discloses a pesticidal composition in particulate form. Nobbs fails to teach a composition wherein the particles contain a magnetic material. However, since a composition composed of a magnetic material is the functional equivalent of a composition comprised of an electrostatic material, in regards to the Nobbs reference, one of ordinary skill in the art would have found it obvious to substitute a magnetic “filler” for the electrostatic “filler” disclosed by Nobbs. Additionally, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

Further, Howse particularly mentions using pesticides and behavior modifying chemicals as additional particles in the composition. Therefore, since it was well known in the art at the time of the invention, one having ordinary skill in the art would have found it obvious to modify the composition of Nobbs, to include pesticides, etc., as taught by Howse, to make the composition more lethal to pests.

In regards to **claim 18**, Nobbs, as modified, teaches a method wherein the pesticide is an insecticide, fungicide, acaricide, insect growth regulator or chemosterilant.

Regarding **claim 19**, Nobbs, as modified, teaches a method wherein the pesticide is a bacterium, virus or fungus.

In regards to **claim 20**, Nobbs, as modified teaches a method wherein the behavior modifying chemical is a pheromone.

Regarding **claim 21**, Nobbs, as modified, discloses the claimed invention except for specifying the amount of cores by weight. However, it would have been obvious to

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one having ordinary skill in the art at the time of the invention to determine a numerical value, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

In regards to **claim 22**, Nobbs, as modified, discloses the claimed invention except for specifying the magnetic material. However, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

Claims 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al.

In regards to **claim 23**, Moore et al. teach an insect trap which comprises a housing or a zone within the housing comprising a magnetically polarized material. Moore et al. fail to teach the zone being coated with a composition comprising particles containing or consisting of a magnetic material of opposite polarity to that of the magnetically polarized material. Instead Moore et al. attach magnetic tape to the zone which in turn coats the housing with magnetic particles. One having ordinary skill in the art would have found it obvious to replace the magnetic tape with a zone constructed of magnetic material since these two processes are functionally equivalent.

Regarding **claim 24**, Moore et al., as modified teach an insect trap wherein the zone of the magnetically polarized material is formed by a portion of at least one wall of the housing.

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In regards to **claim 25**, Moore et al., as modified, teach an insect trap wherein the zone of the magnetically polarized comprises a removable insert placed within the housing. See Figure 1.

Regarding **claim 26**, Moore et al. fail to teach the zone having a surface inclined to the horizontal. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to change the orientation of the zone, since it has been held that rearranging parts of an invention involves only routine skill in the art.

In regards to **claim 27**, Moore et al, as modified, discloses the claimed invention except for specifying the magnetic material as ferromagnetic oxide. However, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

Regarding **claim 28**, Moore et al., as modified, teach an insect trap wherein the zone is coated with particles of a pesticidal composition.

Citation of Relevant Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of art with respect to insect traps and pesticidal compositions:

U.S. Pat. No. 2,167,978 to Jennerich
U.S. Pat. No. 4,044,495 to Nishimura et al.
U.S. Pat. No. 4,263,740 to Hemsarh et al.
U.S. Pat. No. 4,423,564 to Davies et al.
U.S. Pat. No. 5,561,941 to Long

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U.S. Pat. No. 6,216,384 to Dickson et al.

U.S. Pat. No. 6,327,810 to Howse

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan L Piascik whose telephone number is (703)305-0299. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (703)308-2574. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-7687 for regular communications and (703)305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-7687.

slp
August 8, 2002



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